IN THE

Supreme Court of the United States

OCTOBER TERM, 1970

NO. 777

HOLIDAY INNS OF AMERICA, INC.,

Petitioner,

vs.

EUGENE W. ZIMMERMAN, trading and doing business as the HOLIDAY MOTOR HOTELS; HOLIDAY INN HOTEL COURTS, INC., a corporation; HOLIDAY MOTOR HOTEL, INC., a corporation; HOLIDAY MOTEL AND INN, INC., a corporation; and HOLIDAY MOTOR HOTEL RESTAURANT, INC., a corporation,

Respondents.

RESPONDENTS' SUPPLEMENTAL BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE SUPREME COURT OF PENNSYLVANIA

It is respectfully submitted that the Petitioner's Reply Brief proceeds upon the basis of erroneous conceptions, as indicated hereinafter, and proves the validity of the Respondents' Opposition to the Petition for Writ of Certiorari.

1. Petitioner Did Not Raise Any Federal Service Mark Question In Its Pleadings Or At Any Appropriate Stage In This Case.

Petitioner's Reply Brief, as well as its basic position, proceeds on the assumption that the assertion of a claim of "infringement" of a "service mark" is equivalent to the raising of a Federal Lanham Act service mark question. Such is not the case.

The term "service mark" is a generic term which has no reference to any particular statute. Clearly the mere allegation that a party has "infringed" another's "service mark" is insufficient to raise the issue of protection for or infringement of a Federally registered service mark under the Lanham Act. The Pennsylvania Supreme Court has referred to "infringement" of a mark in cases proceeding solely on the principles of the state common law of unfair competition. *KoolVent Metal Awning Corporation of America v. Price* 388 Pa. 528, 533 (1951); *Golden Slipper Square Club v. Gold Slipper Restaurant and Catering, Inc.*, 371 Pa. 92, 96 (1952).

Pages two and three of the Petitioner's Reply proves that the first time there was any mention of a claim relating to any Federal service mark question was on May 9, 1968. This was too late, for the reasons set forth in Respondents' main Brief in Opposition at pages 16-18.

The service of interrogatories and answers thereto does not constitute pleading or otherwise raise an issue. Discovery is not evidence or pleadings and the question of issues and relevancy are governed by the pleadings and the trial.

2. There Is Nothing Misleading In Respondents' Quotations From the Record.

At page six of the Reply, Petitioner quotes a portion of the record. This portion of the record proves the Respondents' position, particularly the language as follows, by counsel for the Respondents: "We are not litigating the Federal effect of it [the registrations of Petitioner's service marks]". (R. 2118a-2119a)

Respondents have in no way misled this Honorable Court, and proof of this is that it was Respondents who certified the record in this case to the Court. The quotations contained in Respondents' Brief in Opposition speak for themselves, and prove that the registrations were offered only to establish that "Holiday" was the key word in the mark at issue. The registrations were offered and admitted for this limited purpose and for no other purpose, as indicated by the Record. (R. 2120a)

3. Conclusion

The Chancellor's "Statement of the Pleadings and Issues Involved" at the beginning of his adjudication (R. 3161a) establishes that Zimmerman sought to enjoin the defendant (Petitioner here) from use of the name "Holiday" in rendering motel, hotel and restaurant services within a geographic part of Pennsylvania.

No policy of any Federal statute was set at naught, or its benefits denied, as indicated by Petitioner in its Reply Brief at page 7. The case of *Sola Electric Company v. Jefferson Electric Company*, 317 U.S. 173 (1942), cited in Petitioner's Reply Brief at page 7, is in no way applicable to the instant case. *Sola Electric* involved a clear

conflict between a state estoppel doctrine and the anti-price fixing policy embodied in the Sherman Act. In the instant case, there is no conflict between Federal Law and the common law of unfair competition as applied by the Pennsylvania state courts. As pointed out by Respondents in their Brief in Opposition (page 30-37) the same result as was achieved in the instant case under the Pennsylvania law of unfair competition would be compelled under the Lanham Act.

Petitioner should not be allowed to clutch at the jurisdiction of this Honorable Court as an afterthought when all other resources of litigation have been exhausted. It is respectfully requested that this Honorable Court decline jurisdiction and deny the Petition for Writ of Certiorari in this case.

Respectfully submitted,

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